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Remarks

Claims 1-27 are pending in the application.

The specification is objected to for an informality.

Claims 1, 5-8 and 12-14 are objected to for various informalities.

Claims 7, 13 and 18 are rejected under 35 U.S.C. 112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, 5-9, 11-16, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Morlitz (US Patent Application Publication #2002/0065800 A1, hereinafter "Morlitz").

Claims 3, 4, 17, 20-23, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morlitz in view of Shanman et al. (US Patent Publication #7,231,357 B1, hereinafter "Shanman").

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morlitz in view of Chow et al. (US Patent Publication #7,216,154B1, hereinafter "Chow").

Claims 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morlitz in view of Shanman, and further in view of Chow.

Each of the various rejections and objections are overcome by amendments that are made to the specification, drawing, and/or claims, as well as, or in the alternative, by various arguments that are presented.

Any amendments to any claim for reasons other than as expressly recited herein as being for the purpose of distinguishing such claim from known prior art are not being made with an intent to change in any way the literal scope of such claims or the range of equivalents for such claims. They are being made simply to present language that is better in conformance with the form requirements of Title 35 of the United States Code or is simply clearer and easier to understand than the originally presented language. Any amendments to any claim expressly made in order to distinguish such claim from known prior art are being made only with an intent to change the literal scope of such claim in the most minimal way, i.e., to just avoid the prior art in a way that leaves the claim novel and not obvious in view of the cited prior art, and no equivalent of any subject matter remaining in the claim is intended to be surrendered.

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Also, since a dependent claim inherently includes the recitations of the claim or chain of claims from which it depends, it is submitted that the scope and content of any dependent claims that have been herein rewritten in independent form is exactly the same as the scope and content of those claims prior to having been rewritten in independent form. That is, although by convention such rewritten claims are labeled herein as having been "amended," it is submitted that only the format, and not the content, of these claims has been changed. This is true whether a dependent claim has been rewritten to expressly include the limitations of those claims on which it formerly depended or whether an independent claim has been rewritten to include the limitations of claims that previously depended from it. Thus, by such rewriting no equivalent of any subject matter of the original dependent claim is intended to be surrendered. If the Examiner is of a different view, he is respectfully requested to so indicate.

#### **Objections to the Specification**

The disclosure is objected to for various informalities.

Applicants have herein amended the specification as indicated by the Examiner.

Therefore, the Examiner is respectfully requested to withdraw the objections.

#### **Objections to the Claims**

Claims 1, 5-8 and 12-24 are objected to for various informalities.

With respect to the objection to claim 1, Applicants have herein amended claim 1 in such a manner that the objection is moot.

With respect to the objections to claims 5-8 and 12-14, Applicants have herein amended the claims for consistency.

With respect to the objection to claim 6, Applicants have herein amended the claim to indicate that a request index file is updated. Support for this limitation may be found at least in Paragraph 0085 of Applicants' originally-filed application.

With respect to the objection to claim 25, Applicants have herein amended claim 25 to remove the extraneous word "based" at the end of the claim.

Therefore, the Examiner is respectfully requested to withdraw the objections.

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**Rejection Under 35 U.S.C. 112**

Claims 7, 13 and 18 are rejected under 35 U.S.C. 112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have herein amended claims 7, 13, and 18 to clarify the resource index file.

Therefore, Applicants' claims 7, 13 and 18 are allowable under 35 U.S.C. 112, ¶2. The Examiner is respectfully requested to withdraw the rejection.

**Rejection Under 35 U.S.C. 102**

Claims 1, 2, 5-9, 11-16, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Morlitz. The rejection is traversed.

Anticipation requires the presence, in a single prior art disclosure, of each and every element of the claimed invention, arranged as in the claim. Morlitz fails to disclose each and every element of the claimed invention, as arranged in independent claim 1.

Specifically, Morlitz fails to teach or suggest at least the limitation of "obtaining said resource and said embedded data using a resource index file having information regarding said resource and said embedded data," as claimed in Applicants' claim 1.

Rather, Morlitz merely discloses that the Web server determines all graphics, audio clips, and other resources needed for a requested Web page, compresses the resources, and creates an archive file containing the compressed resources. Morlitz is devoid of any teaching or suggestion of using a resource index file having information regarding a resource and embedded data in order to obtain the resource and embedded data. As such, Morlitz fails to teach or suggest each and every element of Applicants' claim 1, as arranged in the claim.

In the Office Action, the Examiner asserts (with respect to claim 5, which was cancelled herein, but which included a similar limitation regarding the resource index file) that the meta data including site maps of Morlitz teaches the resource index file of Applicants' claim 1. Applicants respectfully disagree.

Applicants respectfully note that the meta data of Morlitz is not used "for obtaining said resource and said embedded data," as claimed in Applicants' claim 1.

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Rather, the meta data, including the site map, of Morlitz is merely information which is included in the offline file that is sent from the Web server to the client. Specifically, Morlitz states that “[i]n addition to the Web pages and their required resources, the archive file 102 can also contain metadata for the Web site. Metadata (information about the Web site's data) can include such information as site maps, indicating the interrelationship of the Web pages on the site.” (Morlitz, Para. 0030, Emphasis added). Thus, inclusion of meta data in a file sent to a client computer, as taught in Morlitz, does not teach or suggest a resource index file having information regarding a resource and embedded data for use in obtaining the resource and the embedded data which is sent in a file, as claimed in Applicants' claim 1.

Furthermore, the meta data of Morlitz has nothing to do with obtaining the resources of the Web page. Rather, the meta data is used by the client computer to enhance the offline search capability of the client computer. Specifically, Morlitz states that “[t]he inclusion of a site map in the archive file 102 further enhances the off-line search capability of the client computer 10. The site map allows the client computer's Web browser to drill down through a Web site to find the location of the Web page containing the desired information.” (Morlitz, Para. 0038, Emphasis added). Thus, meta data sent to a client computer for use in browsing, as taught in Morlitz, does not teach or suggest a resource index file having information regarding a resource and embedded data for use in obtaining the resource and the embedded data to be sent in a file, as claimed in Applicants' claim 1.

Thus, for at least these reasons, the meta data of Morlitz does not teach or suggest a resource index file having information regarding a resource and embedded data for use in obtaining the resource and the embedded data, as claimed in Applicants' claim 1. As such, Morlitz fails to teach or suggest each and every element of Applicants' claim 1, as arranged in the claim.

As such, independent claim 1 is not anticipated by Morlitz and is patentable under 35 U.S.C. 102. Similarly, independent claims 12 and 16 recite relevant limitations similar to those recited in independent claim 1. As such, for at least the same reasons discussed above, independent claims 12 and 16 also are not anticipated by Morlitz and are patentable under 35 U.S.C. 102. Furthermore, since all of the dependent claims that

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depend from the independent claims include all the limitations of the respective independent claim from which they ultimately depend, each such dependent claim is also allowable over Morlitz.

Therefore, Applicants' claims 1, 2, 5-9, 11-16, 18 and 19 are allowable over Morlitz under 35 U.S.C. 102. The Examiner is respectfully requested to withdraw the rejection.

### **Rejection Under 35 U.S.C. 103**

#### **Claims 3, 4, 17, 20-23, 25 and 27**

Claims 3, 4, 17, 20-23, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morlitz in view of Shanman. The rejection is traversed.

#### **Claims 3, 4, 17**

Each of these grounds of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. 102 given Morlitz. Since the rejection under 35 U.S.C. 102 given Morlitz has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that Shanman supplies that which is missing from Morlitz to render the independent claims anticipated, these grounds of rejection cannot be maintained.

Therefore, Applicants' claims 3, 4 and 17 are allowable over Morlitz in view of Shanman under 35 U.S.C. 103(a). The Examiner is respectfully requested to withdraw the rejection.

#### **Claims 20-23, 25 and 27**

According to MPEP §2143, to establish a prima facie case of obviousness under §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

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expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office Action failed to establish a *prima facie* case of obviousness, because the combination of Morlitz and Shanman fails to teach or suggest all the claim elements.

Independent claim 20 recites relevant limitations similar to those recited in independent claim 1. As such, for at least the reasons discussed above, Morlitz fails to teach or suggest all the claim elements of Applicants' claim 20. Specifically, Morlitz fails to teach or suggest at least the limitation of "obtaining the resource and its embedded data using a resource index file information regarding the resource and its embedded data," as claimed in Applicants' claim 20.

Furthermore, Shanman fails to bridge the substantial gap between Morlitz and Applicants' independent claim 20. Specifically, Shanman also fails to teach or suggest at least the limitation of "obtaining the resource and its embedded data using a resource index file information regarding the resource and its embedded data," as claimed in Applicants' claim 20.

Rather, Shanman merely discloses a system for targeted distribution of coupons over a network. As disclosed in Shanman, in order to distribute coupons to a consumer computer, a link is established between a consumer and a coupon server, and a series of transactions between the consumer and coupon server facilitate distribution of coupons to the consumer.

Shanman, however, is devoid of any teaching or suggestion of a resource index file having information regarding a resource and embedded data for use in obtaining the resource and the embedded data, as claimed in Applicants' claim 1. As such, like Morlitz, Shanman also fails to teach or suggest each and every element of Applicants' claim 1, as arranged in the claim.

Thus, since Morlitz and Shanman each fail to teach or suggest the limitation of "obtaining the resource and its embedded data using a resource index file information regarding the resource and its embedded data," any permissible combination of Morlitz and Shanman (assuming such combination is even possible) must also fail to teach or suggest "obtaining the resource and its embedded data using a resource index file information regarding the resource and its embedded data," as claimed in Applicants'

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claim 20. As such, Molitz and Shanman, alone or in combination, fail to teach or suggest Applicants' claim 20, as a whole.

As such, independent claim 20 is not obvious over Morlitz in view of Shanman and is patentable under 35 U.S.C. 103(a). Furthermore, since all of the dependent claims that depend from the independent claim include all the limitations of the independent claim from which they ultimately depend, each such dependent claim is also allowable over the combination of Morlitz and Shanman.

Therefore, Applicants' claims 20-23 are allowable over Morlitz in view of Shanman under 35 U.S.C. 103(a). The Examiner is respectfully requested to withdraw the rejection.

#### Claim 10

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morlitz in view of Chow. The rejection is traversed.

This ground of rejection applies only to dependent claims and is predicated on the validity of the rejection under 35 U.S.C. 102 given Morlitz. Since the rejection under 35 U.S.C. 102 given Morlitz has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that Chow supplies that which is missing from Morlitz to render the independent claims anticipated, this ground of rejection cannot be maintained.

Therefore, Applicants' claim 10 is allowable over Morlitz in view of Shanman under 35 U.S.C. 103(a). The Examiner is respectfully requested to withdraw the rejection.

#### Claims 24 and 26

Claims 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morlitz in view of Shanman, and further in view of Chow. The rejection is traversed.

Claims 24 and 26 depend from independent claim 20.

This ground of rejection applies only to dependent claims and is predicated on the validity of the rejection under 35 U.S.C. 103 given Morlitz in view of Shanman. Since the rejection under 35 U.S.C. 103 given Morlitz in view of Shanman has been overcome,

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as described hereinabove, and there is no argument put forth by the Office Action that Chow supplies that which is missing from the combination of Morlitz and Shanman to render independent claim 20 obvious, this ground of rejection cannot be maintained.

Therefore, Applicants' claims 24 and 26 are allowable over Morlitz in view of Shanman, and further in view of Chow under 35 U.S.C. 103(a). The Examiner is respectfully requested to withdraw the rejection.



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**Conclusion**

It is respectfully submitted that the Office Action's rejections have been overcome and that this application is now in condition for allowance. Reconsideration and allowance are, therefore, respectfully solicited.

If, however, the Examiner still believes that there are unresolved issues, the Examiner is invited to call Eamon Wall at (732) 530-9404 so that arrangements may be made to discuss and resolve any such issues.

Respectfully submitted,

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